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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/715,199	11/17/2003	Karissa L. Eckert	86093JLT	3341
7590	05/25/2005		EXAMINER	
Paul A. Leipold Patent Legal Staff Eastman Kodak Company 343 State Street Rochester, NY 14650-2201			SCHILLING, RICHARD L	
			ART UNIT	PAPER NUMBER
			1752	
DATE MAILED: 05/25/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/715,199	ECKERT ET AL.
Examiner	Richard L. Schilling	Art Unit 1752

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 09 May 2005.

2a)  This action is FINAL.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

4)  Claim(s) 1-33 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-33 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 3-31-95.

4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_ .  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other:

1. Claims 1, 2, 4, 6-8, 11-15, 17, 26, 28 and 30 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Masukawa et al. in view of Gutman. Masukawa et al. (see particularly column 5, line 30 - column 6, line 5; column 27, line 65 - column 28, line 68; column 30, lines 16-60; column 2, lines 63-68; Example 1) discloses photothermographic elements comprising silver halide, organic silver salts, reducing agents and toning agents. The preferred organic silver salt is silver benzotriazole and the reducing agents include ascorbic acids. The toning agents include phthalic acid within the scope of structural Formula 1 of instant claim 2. Example 1 uses silver benzotriazole and phthalic acid. Gutman (see particularly column 5, lines 1-16) discloses photothermographic elements with silver halide and organic silver salts and discloses that when silver benzotriazole is used as an organic silver salt, ascorbic acids are preferably used as reducing agents. Therefore, it would be obvious to one skilled in the art to use the disclosed ascorbic acids of Masukawa et al. as the called for reducing agents in Masukawa et al. particularly in Example 1 which have silver benzotriazole and phthalic acid since ascorbic acids are preferred reducing agents for silver benzotriazoles as disclosed in Gutman.

2. Claims 1-4, 6-15, 17, 26, 28 and 30 are rejected under

35 U.S.C. § 103(a) as being unpatentable over Hirai et al. in view of Gutman. Hirai et al. (see particularly column 1, line 33 - column 2, line 30; column 6, lines 45-60; column 7, lines 51-55; column 12, line 40 - column 13, line 7) discloses photothermographic elements comprising silver halide, organic silver salts including silver benzotriazole wherein acids, including carboxylic acids, are added to the photothermographic layers to lower the pH in order to lower fog and provide high storage stability. Ascorbic acid is not disclosed as a reducing agent. However, since Gutman (see particularly column 5, lines 1-16) discloses the use of ascorbic acid as preferred reducing agents in photothermographic elements containing silver benzotriazoles, it would be obvious to one skilled in the art to use ascorbic acid as the called for reducing agent in the photothermographic elements of Hirai et al. containing silver benzotriazole. The acids used in Hirai et al. include those set forth in instant claim 2.

3. Claims 1, 2, 4-8, 11-28, 30 and 31 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Hirano et al. in view of Gutman. Hirano et al. (see particularly column 1, line 49 - column 2, line 25; column 50, lines 1-43; column 45, lines 49-58; column 56, lines 56-57; column 63, lines 47-58) discloses photothermographic elements comprising silver halide, including

tabular silver halide, organic silver salts, including silver salts of imino compounds, and reducing agents, including ascorbic acid reducing agents. The photothermographic elements in Hirano et al. are disclosed as containing phenyl dicarboxylic acid compounds as storage stabilizers. Hirano et al. does not specifically set forth the combination of silver benzotriazoles and ascorbic acids as reducing agents. However, since Gutman (see particularly column 5, lines 1-16) discloses the use of ascorbic acids as preferred reducing agents in photothermographic elements containing silver benzotriazoles, it would be obvious to one skilled in the art to use the combination of silver benzotriazoles and ascorbic acid reducing agents as the called for organic silver salts and reducing agents in Hirano et al.

4. Claims 5, 16 and 20-22 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Hirai et al. and Gutman as applied in paragraph 2 above further in view of Hirano et al. The combination of Hirai et al. and Gutman makes photothermographic elements containing silver halide, organic silver salts and benzotriazole and ascorbic acid reducing agents and the acids of Hirai et al. obvious to one skilled in the art. Since Hirano et al. disclose that tabular silver halide grains may be used as the silver halide catalysts in photothermographic elements comprising organic silver salts and reducing agents, it

would be obvious to one skilled in the art to use tabular silver halide grains as in Hirano et al. as the called for silver halide grains in the photothermographic elements of Hirai et al.

5. Claims 18-25 and 27-33 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Masukawa et al. and Gutman as applied in paragraph 1 above, the combination of Hirai et al. and Gutman as applied in paragraph 2 above, the combination of Hirano et al. and Gutman as applied in paragraph 3 above or the combination of Hirai et al., Gutman and Hirano et al. as applied in paragraph 4 above all further in view of Lyons et al. and Simpson et al. Lyons et al. (see particularly column 6, lines 46-52; column 3, lines 21-26) and Simpson et al. (see particularly column 5, lines 36-60) discloses that it is known in the art to use photothermographic compositions comprising silver halide, organic silver salts and reducing agents with optional toners as X-ray recording films which are exposed using phosphor screens and which compositions may be coated on both sides of a support. Since Simpson et al. and Lyons et al. disclose that photothermographic elements of the type set forth in paragraphs 1-4 above may be used with phosphor screens to record X-rays, it would be obvious to one skilled in the art to use the photothermographic elements of paragraphs 1-4 above with phosphor screens and in dual coated elements for recording X-rays.

6. The comparisons in applicants' specification are noted but are unconvincing since they fail to show the criticality of using silver benzotriazole as the organic silver salt and ascorbic acid or reductone as the reducing agents and are not commensurate in scope with the claimed subject matter as explained in paragraph 5 of the first Office action filed February 10, 2005. Also, it would still be obvious to one skilled in the art to use toning agents including phthalic acid to tone the silver images in the photothermographic elements of the applied prior art even if the phthalic acid has the secondary property of increasing stability.

7. Claims 1, 2, 4, 6-8, 11-15, 17, 26-28 and 30 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Gutman. Gutman (see particularly column 2, line 14 - column 3, line 30; column 5, lines 1-16; column 4, lines 32-68) disclose photothermographic elements comprising silver halide, organic silver salts of benzotriazole and toner catalysts of polycarboxylic acid within the scope of structural Formula I of claim 2. The preferred reducing agents for use with silver benzotriazole are disclosed as ascorbic acids. If Gutman does not anticipate the instant claims, then it would at least be obvious to one skilled in the art to use the combination of

silver benzotriazoles and ascorbic acids as the called for organic silver salts and reducing agents in Gutman.

8. Claims 5, 16 and 20-22 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Gutman and Hirano et al. Gutman discloses photothermographic elements comprising silver halide, organic silver salts, including silver benzotriazoles and reducing agents which are preferably ascorbic acids for silver benzotriazoles. Gutman also discloses polycarboxylic acid toners within the scope of the structure of instant claim 2. Hirano et al. discloses photothermographic elements containing silver halide, organic silver salts and reducing agents like those of Gutman and further discloses that tabular silver halide grains may be used as the silver halide grains. Since Hirano et al. discloses that tabular silver halide grains may be used in photothermographic elements as in Gutman, it would be obvious to one skilled in the art to use tabular silver halide grains as in Hirano et al. as the called for silver halide grains in the photothermographic elements of Gutman.

9. Claims 18, 19, 23-25 and 27-33 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Gutman with Lyons et al. and Simpson et al. Gutman et al. discloses photothermographic compositions comprising silver

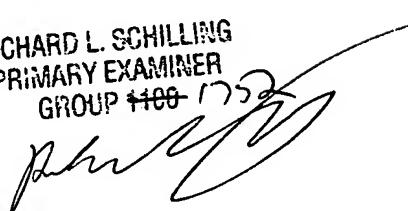
halide, organic silver salts, including silver benzotriazoles, reducing agents, preferably including ascorbic acids for silver benzotriazoles, and acid toners as set forth by the structural formula of instant claim 2. Since Lyons et al. (see particularly column 6, lines 46-52; column 3, lines 21-26) and Simpson et al. (see particularly column 5, lines 36-60) discloses that photothermographic compositions comprising silver halide, organic silver salts, reducing agents and optionally toners, may be used for recording X-rays and may be coated on both sides of a support for X-ray exposure using phosphor screens, it would be obvious to one skilled in the art to use the photothermographic compositions of Gutman et al. for recording X-rays using phosphor screens. It would be obvious to one skilled in the art to use the particular photothermographic compositions of Gutman et al. as the called for photothermographic compositions in Lyons et al. and Simpson et al. in the X-ray elements of Lyons et al. and Simpson et al.

10. The Declaration submitted under 37 CFR 1.131 has removed Zou et al. as a reference.

11. Any inquiry concerning this communication should be directed to Mr. Schilling at telephone number (571) 272-1335.

RLSchilling:cdc

RICHARD L. SCHILLING  
PRIMARY EXAMINER  
GROUP 1100 1752



Serial No. 10/715,199

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Art Unit 1752

May 24, 2005

RICHARD L. SCHILLING  
PRIMARY EXAMINER  
GROUP 1752

